

Applicant: Trinh et al.  
Serial No.: 10/632,415  
Group Art Unit: 2873

PATENT  
Docket No.: 10-9404

### **REMARKS**

This Amendment is filed in response to the Office Action dated September 21, 2004. In this Amendment, claims 1, 9, and 14 are amended. Claims 18-21 are added. No new matter has been added by way of these amendments. Upon entry of this amendment, claims 1-14 and 16-21 shall be pending and awaiting further examination.

In the Office Action, various objections and claim rejections have been asserted against claims 1-17. For at least the reasons set forth below, these rejections and objections are hereby traversed. Moreover, it is respectfully submitted that this Amendment resolves all remaining issues, thus placing all pending claims in condition for allowance. Hence, it is submitted that entry of this Amendment is proper.

### **Objections to the Specification**

The Examiner has objected to the specification as failing to comply with 37 CFR 1.84(p)(5), directing attention to reference numeral 20, which appears in the Figures but is not mentioned in the specification. Numeral 20 is directed to a meniscus described in paragraph [0056]. Paragraph [0056] has been amended to include this reference numeral. No changes have been made to the drawings and no new matter has been added by way of this amendment. The Applicant respectfully submits that all objections to the specification have been overcome by this amendment.

### **Claim Objections**

The Examiner has objected to Claim 1 as reciting "the optical lens" without proper antecedent basis. In response, claim 1 has been amended to recite "the optical element." Hence, it is requested that the objection be withdrawn.

Applicant: Trinh et al.  
Serial No.: 10/632,415  
Group Art Unit: 2873

PATENT  
Docket No.: 10-9404

**Claim Rejections under 35 USC § 102(e)**

The Examiner rejected claims 1-2, 6-10, and 12-15, of which claims 1, 9, and 14 are independent, under 35 USC § 102(e) as being anticipated by U.S. Patent No. 6,355,104 to *Polster*. For at least the reasons set forth below, these rejections are hereby traversed.

Amended claim 1 recites a method that includes creating a meniscus between the optical element and the coating solution bath when the optical element is otherwise above the coating solution bath so as to allow capillary forces to wick off a desired amount of the coating solution from the optical element. *Polster* fails to teach at least this portion of claim 1. Indeed, *Polster* teaches away from doing so. For example, at Column 8 lines 38-42 of *Polster* it is stated that, "At the end of the treatment, when the article is just out of the treatment bath, a quick jump made up of a series of quick steps may be made in the raising of the article to break off any meniscus attached to the article." Hence, *Polster* is suggesting an avoidance of a meniscus instead of an intentional creation of a meniscus as in the present invention. Accordingly, the advantageous wicking of the present invention is not achieved with *Polster*.

Turning to claim 9, claim 9 recites a method that includes maintaining a touching of a bottom portion of the eye element with the coating solution for a predetermined period of time sufficient to effect a wicking of excess solution from the element. As cited above, *Polster* teaches away from any such touching of the coating solution with the bottom portion of the eye element at Column 8 lines 39-42. Hence, as with respect to claim 1, *Polster* cannot provide the advantageous wicking of excess solution from the element.

Applicant: Trinh et al.  
Serial No.: 10/632,415  
Group Art Unit: 2873

PATENT  
Docket No.: 10-9404

Turning lastly to claim 14, claim 14 recites an eye lens wherein the coating is free of a visually observable light wedge due to the coating solution being wicked from an edge of the lens substrate through a meniscus created between said coating and said edge of said lens substrate at the conclusion of said dip coating method. To reject claim 14, the Examiner relies on *Polster* at Column 8 lines 36-37 where it is said, "Due to the meniscus effect, this will tend to form a uniform gradient rather than lines of coating." Applicant respectfully submits that this reference has nothing to do with using a meniscus created between the coating and the edge of the lens at the conclusion of the coating method as claimed. Rather, the meniscus disclosed in *Polster* is used simply to attempt to blur the lines that would otherwise be created during the incremental removal process used by *Polster*. Indeed, *Polster* actually discourages the formation of a meniscus at the conclusion of the dip coating method as discussed above.

In view of the foregoing, the Applicant respectfully submits that the rejections of claims 1, 9 and 14 under 35 U.S.C. § 102(e) cannot be properly maintained and that the rejections should be withdrawn.

### **Rejections under § 103**

The Examiner has rejected independent Claim 16 as being unpatentable over *Polster*. As the Examiner admits, *Polster* does not specifically disclose that the coating in *Polster* has a visible light transmission differential from a top to a bottom of the lens substrate of approximately 1.5% as in claim 16 yet nonetheless asserts that this would be obvious to achieve in the *Polster* process. In response, the Applicant asserts that the method of *Polster* is incapable of achieving the small visible light transmission differential claimed because *Polster* does not teach a method that would yield this result. Indeed, *Polster*, at Column 8 lines 38-42, teaches away from the very wicking step a method that would

Applicant: Trinh et al.  
Serial No.: 10/632,415  
Group Art Unit: 2873

PATENT  
Docket No.: 10-9404

achieve such results. And in this regard, a light transmission differential is not a degree of tint, as the Examiner suggests on page 8 of the Action. Rather, a light transmission differential of 1.5% is a quality control standard achieved by the present invention. Therefore, it is submitted that the rejection of Claim 16 cannot be properly maintained and that the rejection should be withdrawn.

### **Dependent Claims**

Claims 2-8, 10-13, 15 and 17 each variously depend either directly or indirectly from independent claims 1, 9, 14 and 16. They have also been variously rejected under 35 U.S.C. § 102 and or 103 based on *Polster* alone or in combination with U.S. Patent No. 4,291,097 to *Kamada et al.* For at least the reasons set forth above, these claims are also submitted as being patentable. However, these claims further define and describe the invention and thus are separately patentable.

### **New Claims**

Claims 18-21 have been added by way of this Amendment. These claims recite the invention in a manner similar to the claims discussed above. It is submitted that these claims are also patentable over *Polster* as well as the remaining cited prior art.

Applicant: Trinh et al.  
Serial No.: 10/632,415  
Group Art Unit: 2873

**PATENT**  
Docket No.: 10-9404

### CONCLUSION

In view of the foregoing, it is submitted that all claims pending after entry of this amendment (namely, claims 1-14 and 16-21) are in condition for allowance. Hence, entry of this Amendment is proper and is earnestly requested.

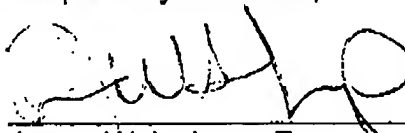
If any questions or issues arise that are more easily addressed by the Examiner through direct communication with the undersigned, the Examiner is cordially to contact the undersigned at the number listed below.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,

Dated:

JAN 21 2005



James W. Inskeep, Esq.  
Registration No. 33,910

INSKEEP INTELLECTUAL PROPERTY GROUP, INC.  
1225 W. 190<sup>th</sup> Street, Suite 205  
Gardena, CA 90248  
Telephone: (310) 217-6220  
Facsimile: (310) 327-0282

*Customer No. 37,374*